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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,181

02/06/2007

Jason E. Rehm

14045-1US

4395

66111 7590 12/12/2008
EKSIGENT TECHNOLOGIES, LLC
c/o SHELDON MAK ROSE & ANDERSON
100 East Corson Street
Third Floor
PASADENA, CA 91103-3842

EXAMINER

BROWN, PHYLLIS

ART UNIT

PAPER NUMBER

3753

MAIL DATE

DELIVERY MODE

12/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,181	Applicant(s) REHM ET AL.	
	Examiner MACADE BROWN	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) 28-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/30/08, 3/03/08, & 03/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 28-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/18/08. Applicant's election without traverse of claims 1-27 and 41-49 in the reply filed on 11/18/09 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-27, and 41-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasselbrink, J.r. (PG-Pub 2002/0194909).

Regarding claims 1, 3-6, 18-20, and 27, Hasselbrink, J.r. discloses a device including a conduit (see fig. 1) having a first end (see 141) and a second end (see 140), a first path 130 in fluid flow contact with the conduit, a second path 131 in fluid flow contact with the conduit, and a regulator 120 that is moveable in the conduit, wherein the regulator 120 has an outer dimension that is larger than the first end and the second end so the regulator cannot pass out of the conduit, the regulator 120 (fig. 1) comprises a substantially elastic material having a structural component (para. 15); further

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including a substrate (para. 33); a third path 133 (fig. 9) in fluid flow contact with the conduit; wherein there are a plurality of regulators 1140/1130/1120/1150 (fig. 11) that are moveable in the conduit, each regulator 1140/1130/1120/1150 having an outer diameter that is larger than the first and second flow paths so the regulators cannot pass out of the conduit, and wherein each regulator 1140/1130/1120/1150 is a substantially elastic material having a structural component wherein the composite mixture comprises a photo initiator (para. 74); wherein the regulator is substantially incompressible; wherein the regulator has an optical property (para. 81); wherein in the regulator has a substantially stable volume when exposed to fluid.

Regarding claims 22 and 23, Hasselbrink, J.r. discloses the regulator is substantially cylindrically shaped and moveable in a back and forth motion; and substantially toothed wheel shaped and rotationally moveable within the conduit (fig. 10; para. 81).

Regarding claims 21, Hasselbrink, J.r. discloses the claimed invention except that the inner dimension of the conduit is less than about 1 millimeter. Although Hasselbrink, J.r. doesn't explicitly disclose the inner dimension of the conduit is less than about 1 millimeter, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device.

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Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Regarding claims 2, 7-17, 24-26, 41-49, Hasselbrink, J.r. discloses the substantially elastic material having a structural component is a composite polymer (para. 15). The examiner notes the patentability of a product does not depend on its method of production (i.e. formed from a composite mixture including polymerizable precursor and particulate filler, photo-initiator is fluorinated, and halogenated polymer). If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blomquist (PG-Pub 2003/0176629).

Regarding claim 8, Hasselbrink, J.r. discloses essentially all claimed features, except wherein the photo-initiator is an aromatic ketone.

Blomquist teaches the photo-initiator is an aromatic ketone to provide a free radical thermally inactive initiator (para. 51).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to employ in Hasselbrink, J.r. an aromatic ketone photo-initiator, as taught by Blomquist, for the purpose of providing a free radical thermally inactive initiator.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACADE BROWN whose telephone number is (571)270-5428. The examiner can normally be reached on Mon-Thurs, 8am-4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./
Examiner, Art Unit 3753

/John Rivell/
Primary Examiner, Art Unit 3753